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EXAMINER

ARYANPOUR, MITRA

ART UNIT PAPER NUMBER

3711

DATE MAILED: 01/12/2004

121

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/053,289

Applicant(s)

CLARK ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The use of the trademark VELCRO has been noted in this application as originally filed and in the amendment filed 23 June 2003. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks (see page 4 of the amendment).

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no support in the specification as originally filed for the newly added term “self securing strap”. See page 4, lines 1, 7 and 22 of the specification. Applicant has broadly stated that an attachment means (22) can be used and has given a few examples, such as tape, adhesive, or suction cup. The specification also indicates that alternatively it could be molded. Additionally, reference has been made to the use of VELCRO as an anchor. Although, VELCRO can be self securing, it does not suggest that any other type of self securing means can be used, since when using the term “self securing strap” it includes a broader range of attachment means which the Specification as originally filed does not provide support for. Therefore, the mere use of the word VELCRO does not convey to one of ordinary skill in the art that all types of “self securing” means can be substituted for VELCRO. One-way of avoiding the above objection is to use the term VELCRO and define it as hook-and-loop or hook-and-pile type strap.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the newly added limitation. In claim 1, line 4; claim 13, line 5; and claim 18, line 8, the specification and claims as originally filed provide no support for the bunt aid having an outer diameter of greater than about 6 inches (see page 5, lines 7-12). What is disclosed in the specification (see page 5, lines 7-12) is as follows: "While almost any dimensional configuration is possible, one effective bunt aid has an outer diameter "d" of about 6 inches for conventional baseball bats and 7 inches for conventional softball bats . . .". The above statement, merely indicates that for a baseball bat the diameter of the bund aid is about 6 inches and not more than 6 inches. The heritage dictionary defines "about" as approximately or nearly. As for a softball bat it says it is 7 inches and only 7 inches, no other dimensions have been suggested. What is disclosed in this application as originally filed, does not suggest that the cup for a baseball bat can have a diameter greater than 6 inches. "greater than" means it is more than not less than, therefore, one of ordinary skill in the art would not have inherently understood without further teaching that "about" means "a minimum". One

way of avoiding the above rejection is to simply claim what is stated in the specification, that being "about 6 inches".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4-11, 13-16, 18 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Genjack (3,169,019).

Regarding claim 1, Genjack discloses at least one cup (11); at least one strap (30) attached to the cup (11), wherein the strap is adapted to secure the cup to the bat (25). Genjack is silent as to the material used to make the cup (11). However, referring to figures 4 and 6, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. As it is well known both material have some degree of resiliency. The degree of resiliency varies depending on the shore hardness of the material. Regarding the limitation "at least one cup having an outer diameter of greater than about 6 inches" inasmuch as applicant has shown and defined a cup having a diameter greater than 6 inches, Genjack also shows a cup having a diameter greater than 6 inches.

Regarding claim 2, Genjack shows the strap is detachably coupled to the at least one cup (see column 2, lines 12-35); and a length sufficient to wrap around the barrel (see figure 1).

Regarding claim 4, Genjack further shows the cup (11) is positionable along the bat (25).  
See figure 1.

Regarding claim 5, Genjack further shows the cup (11) having a seating surface (20) adapted to be secured adjacent to the bat (25), and sidewalls (13) having a rim, wherein the rim defines an opening (see figures 2 and 6).

Regarding claim 6, Genjack further shows the sidewalls (13) tapering generally outwardly (see figure 4).

Regarding claim 7, Genjack shows the seating surface having a substantially funnel shape (see figure 2).

Regarding claims 8 and 9, Genjack also show the opening defining a geometrical shape such in a circle (see figure 2).

Regarding claim 10, Genjack shows the seating (20) having an opening (33).

Regarding claim 11, as best seen from figures 2 and 3, Genjack shows the cup having a rim and the rim having a lip portion which has an outer, inner and transition portion and generally parallel to the bat surface (see figure 1).

Regarding claim 13, see comments for claim 1.

Regarding claim 14, Genjack further shows the device to be used for catching a ball, which would inherently direct the bat towards the ball upon impact (see column 1, lines 14-16).

Regarding claim 15, see comments for claim 4.

Regarding claim 16, Genjack's cup upon catching or impacting a ball would inherently deaden the impact of the ball on the bat.

Regarding claim 18, see comments for claim 1. Additionally, Genjack shows the cup being attached to a bat (see figure 1), wherein the bat has a handle portion, a barrel portion and an intermediate portion.

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Regarding claim 20, see comments for claim 2.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 12, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Genjack (3,169,019).

Regarding claim 3, Genjack shows the strap to be a continuous loop. Official Notice is taken that modifying a continuous loop strap (one-piece) to a two-part strap would have been an obvious choice of design and it would have been obvious to do so here, since it would make the device more readily detachable.

Regarding claim 12, Genjack is silent as to the material used for making the cup (11). However, referring to figures 4 and 6, the symbol (shading) used to indicate the cross section of the cup, suggests that the material is a synthetic resin or plastic. Absent a showing of new or unobvious results, it would have been obvious to use any well-known material including rubber, foam, leather, metal, wood, etc. for the cup of Genjack, the motivation being depending on the availability and the suitability of the material.

Regarding claim 19, Genjack shows the cup or bunt aid (11) to be releasably attached to the bat. It would have been obvious to one of ordinary skill in the art to have made the cup integral with the bat, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *In re*

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*Larson* 144 USPQ 347 (CCPA 1965), and it would have been obvious to do so here, the motivation being it would require less parts.

Regarding claim 21, see comments for claim 12.

9. Claims 13, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tyner (6,254,498).

Regarding claim 13, Tyner shows an instructional device (10) having resilient means (15; see column 4, lines 16-26) to improve bunting skills; the means for simulating the catching of a ball with the bat; and means for attaching the simulating means to the bat (see column 5, lines 1-7).

Regarding claim 14, Tyner shows the simulating means (15) is positioned on the bat in order to strike a ball, therefore, it would inherently guide the bat to the ball.

Regarding claim 16, Tyner shows the means for simulating (15) would inherently deaden the impact of the ball on the bat.

Regarding claim 17, Tyner further shows the instructional device (15) adjustably positioned on a training bat (10), wherein the means to simulate is a sleeve (see figure 3).

#### ***Response to Arguments***

10. Applicant's arguments filed 23 June 2003 have been fully considered but they are not persuasive. The features that applicant relies upon are new matter see comments under the objection to the specification and 112 1<sup>st</sup> rejection.


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



**MITRA ARYANPOUR**  
**PATENT EXAMINER**

MA  
9 January 2003